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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/086,417

03/04/2002

Bernd Riedl

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08/08/2006

EXAMINER

HENLEY III, RAYMOND J

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.

2200 CLARENDON BLVD.

SUITE 1400

ARLINGTON, VA 22201

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,417

Applicant(s)

RIEDL ET AL

Examiner

Raymond J. Henley III

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 39-53 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,6,12 and 39-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/2/02 & 10/4/05.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

CLAIMS 1-12 AND 39-53 ARE PRESENTED FOR EXAMINATION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Because this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicants' submission, which included an Information Disclosure Statement and a "Request for Initialed Form PTO/SB/08A (Substitute for 1449A/PTO)", filed on October 4, 2006 has been entered. As reflected by the attached, completed copies of form PTO/SB/08A, the cited references have been considered in-part. The references listed at pages 6-8 of form PTO/SB/08A apparently were not captured on the compact discs referenced in Applicants' above mentioned request. As such, these references have not been considered. Applicants are respectfully requested to submit copies of these references and, if possible, provide the reference date, i.e., year, on the appropriate pages of form PTO/SB/08A. Also, one sheet of form PTO/SB/08A filed October 4, 2006 is the same as that filed April 2, 2002, (which sheet has been completed by the Examiner and is attached hereto), and has been marked as "duplicate".

Applicants are notified that a new Examiner has been assigned the duty of examining the present application. Contact information for this Examiner may be found at the close of this action.

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Election/Restriction

As per the election of species requirement dated July 8, 2003, claims 2, 5, 6, 12 and 39-53 remain withdrawn from consideration as being directed to subject matter that was not elected, such election having been made with traverse in Applicants' communication filed August 8, 2003. The remaining claims, i.e., claims 1, 3, 4 and 7-11 are herein acted on the merits.

Claim Rejection - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3, 4 and 7-11 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Salituro et al., (U.S. Patent No. 6,093, 742), already of record, for the reasons of record as maintained in the previous Office action dated February 10, 2004 at pages 7 and 8, which reasons are here incorporated by reference.

Applicants' remarks presented in their after-final submission dated February 7, 2005 have been carefully considered, but fail to persuade the Examiner of error.

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In particular, in attempting to refute the propriety of the present rejection, Applicants have taken the position that in the definitions for "W" and "Z", Salituro et al. limit the substitutions to only occur on the ring which is attached directly to the urea moiety. In support of their position, Applicants' have reproduced the section of the patent where such definitions are found and by pointing to the examples of the patentees. Also, Applicants have pointed to the preferred compounds of the patentees at col. 38, lines 43-47 where none of such compounds have a remote aryl substitution. This position is not found persuasive because no mention is found in the definitions of either "W" or "Z" where substitution is limited only to the ring attached directly to the urea moiety. Indeed, in both of the definitions, it is stated that bicyclic ring systems are included in the definitions of "W" or "Z" and that either "W" or "Z" may be optionally substituted, (e.g., col. 2, lines 10-14 and 34-41). This facet of the patentees discovery is also exemplified in compound 80, (col. 23), where the ring which is remote to the urea moiety is substituted with an alkyl group. This example is also in opposite of Applicants' remarks at page 3 of their submission where it is averred that the patentees' "specification provides no further details with respect to substituting the remote C₆₋₂₀ groups and *none are illustrated...*", (emphasis added). Also, that none of the preferred compounds carry such a remote substitution is not persuasive because it is well settled that "Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971)", (MPEP § 2123(II)). Thus, the Examiner is not persuaded to give the teachings of the patentees the limited interpretation as urged by Applicants.

Accordingly, for the above reasons, the claims are deemed properly rejected.

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Provisional

Claims 1, 3, 4 and 7-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the pending claims of U.S. Application Serial Nos. 09/889,227, 10/071,248, 09/948,915, 10/361,858, 09/993,647, 10/042,203, 10/361,859, 10/308,187 or 10/895,985. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims have not been limited to a particular species or group of species and thus, the generic form of the present claims renders the presently claimed subject matter not patentably distinct over the claims of the above referenced U.S. Applications.

Applicants should either clearly demarcate the claims of these several applications or file an appropriate terminal disclaimer.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

None of the claims are currently in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Henley III whose telephone number is 571-272-0575. The examiner can normally be reached on M-F, 8:30 am to 4:00 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Raymond J Henley III
Primary Examiner
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August 3, 2006